REMARKS

Applicant has carefully reviewed the Application in light of the Final Office Action dated September 19, 2008 ("Office Action"). Claims 2, 9, and 12 were previously cancelled. Claims 1, 4, 10, and 11 are amended as set forth above. Thus, Claims 1, 3–8, 10, 11, and 13–17 remain pending in the application. Applicant submits that no new matter has been added with the amendments. Applicant respectfully requests reconsideration of the application in accordance with the following remarks.

Section 112 Rejections

Claims 1, 10, and 11 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Further, Claims 1, 10, and 11 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Office Action rejected Claims 1, 10, and 11 on the grounds that the phrase "the text content in an unambiguous reading order" fails to meet the requirements of 35 U.S.C. § 112, first and second paragraphs. Applicant disagrees with the Office Action's characterization that Claims 1, 10, and 11 fail to satisfy the requirements of 35 U.S.C. § 112, first and second paragraphs. However, to further prosecution, Applicant has amended the claims to recite "converting the text content into a canonical form, wherein the text content is in an unambiguous reading order." Applicant notes that such amendments are for clarification purposes only and do not affect the scope of the claims. Accordingly, Applicant respectfully requests withdrawal of the rejection.

The claims are allowable over the cited art

Claims 1, 3–8, 10, 11, and 13–17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0069179 to Slater *et al.* ("*Slater*") in view of U.S. Patent No. 6,634,559 to Shioda ("*Shioda*"). Applicant respectfully traverses the rejection and assertions and holdings therein, because the above cited art, whether individually or in combination, fails to teach, suggest, or disclose certain aspects of the present claims including, for example, Claim 1.

At the outset, Applicant respectfully notes that the combination of *Slater* and *Shioda* is improper because *Shioda* actually teaches away from combining with *Slater*. For example, the Office Action argues that *Slater* teaches an electronic document further having a human readable document appearance. *See*, *e.g.*, *Slater* ¶ 31. But *Shioda* teaches away from a document in human-readable form. Specifically, *Shioda* teaches that "the data sheet is effective for maintaining secrecy, since data recorded on the data sheet is encoded so that *a user cannot recognize contents of the data just by looking at the data*." *Shioda*, 6:44–46 (emphasis added). Because *Shioda* teaches away from a document in human-readable form, there would be no motivation to combine *Shioda* with *Slater*. Therefore, it has not been shown that *Slater* in view of *Shioda* renders Claim 1 obvious and the combination is improper. Accordingly, Applicant respectfully requests withdrawal of the rejection.

Regardless of the propriety of the combination, it has not been shown that *Slater* – even in view of *Shioda* – teaches the following elements:

- attaching one or more approval codes to the electronic document, such that when the document is printed, each approval code generates an approval mark;
- generating control codes for the electronic document as part of a workflow in the workflow system;
- one or more first control codes that each correspond to a respective approval code;
- one or more second control codes generated from the canonical form of the text content;
- creating a print out, the print out including, *inter alia*,

  (i) the respective approval mark corresponding to each approval code,

  (ii) the one or more first control codes, which are usable to authenticate the one or more respective approval marks, and

  (iii) the one or more second control codes, which are usable to validate the text content of the print out.

Indeed, the Office Action admits that *Slater* does not teach generating an electronic document in a workflow system for use with an external entity that does not exchange electronic documents with the workflow system. *See* Office Action at 6. And *Shioda* fails to overcome these

deficiencies of *Slater*. Therefore, *Slater* – even in view of *Shioda* – does not render the above claims obvious.

First, it has not been shown that *Slater* teaches, suggests, or otherwise discloses "attaching one or more approval codes to the electronic document, such that when the document is printed, each approval code generates an approval mark" as recited in Claim 1. The Office Action cites to paragraph 30 of *Slater* to argue that *Slater* teaches this element of Claim 1. *See* Office Action at 7. On the contrary, *Slater* merely teaches that "persons who will digitally sign the electronic document usually examine the document for completeness and then sign the document." *Slater* ¶ 30. For example, the cited portion of *Slater* does not teach "attaching one or more approval codes" wherein "each approval code generates an approval mark" when the document is printed. Although *Slater* does teach printing the document (*see Slater* ¶ 64), there is no teaching or suggestion of generating an approval mark from an approval code upon printing the document. Further, the Office Action does not cite to *Shioda* for some teaching of printing an approval mark generated from an approval code.

Second, *Slater* fails to teach, suggest, or otherwise disclose "generating control codes for the electronic document as part of a workflow in the workflow system." The Office Action advances the argument that *Slater* teaches generating control codes by disclosing signature blocks added to the document, which contain signatures. *See* Office Action at 8 (citing *Slater* ¶ 29–32). The Office Action continues by stating that the "digital signatures are encrypted . . . and therefore the encrypted digital signature creates a control code for verification of the digital signature." *Id.* (citing *Slater* ¶ 13). But *Slater* does not explicitly teach an encrypted digital signature. Specifically, while the Office Action makes reference to a decryption of a digital signature to infer that *Slater* discloses generating control codes, *Slater* does not disclose a method for encrypting the digital signature; as such, assuming *Slater* teaches the affirmative step of generating control codes is inappropriate. That aside, it has not been shown that *Slater* teaches, suggests, or otherwise describes generating control codes. Instead, *Slater* teaches that the signature blocks are "used to contain the digital signature of the signer as well as other information." *Slater* ¶ 56. The signature blocks contain "a reconstruct attribute that is used when the electronic document is validated or verified." *Slater* ¶ 12. "The reconstruct attribute helps to reconstruct the document to a previous state by helping identify information or data that should

be removed or stripped from the *electronic document*." *Slater* ¶ 13 (emphasis added). "Once the document has been reconstructed, it is hashed to generate a hash value that is compared to a decrypted value of the digital signature of the signer being validated." *Slater* ¶ 13. In other words, *Slater* teaches encrypting a hash value associated with the *recorder* signatures, and not encrypting the signatures themselves as argued by the Office Action. *See Slater* ¶ 74. Next, the reconstruct attributes described above only allow a verifier to put the document into a previous stage or state, and so is not analogous to a control code. *See Slater* ¶¶ 66, 74. Therefore, there are no aspects of the signature blocks from *Slater* that are similar or analogous to the control codes described by Claim 1.

Still further, it has not been shown that *Slater* teaches, suggests, or otherwise describes "the control codes including one or more second control codes generated from the canonical form of the text content." The Office Action advances the argument that *Slater* teaches the above element by "signing the entire document, For [sic] example by a notary or recorder after primary signers sign the document. The signature by notary or recorder applies to the content of the document, which . . . includes a canonically converted text." Office Action at 8. Nothing in the quoted language from the Office Action teaches, suggests, or otherwise discloses one or more second control codes. As stated in the claim, the second control codes are generated from the canonical form of the text content. The Office Action's argument that the signature applies to the content would apply the signature of a notary or recorder to the document irrespective of the form of the content. Second, the signature from *Slater* is not generated from the content; rather, the signature *is* the content. *See Slater* ¶ 13 ("Because the digital signatures are embedded in the electronic document, they cannot become disassociated from the digital document."). Regardless, there is no explicit disclosure in *Slater* of a second control code.

Next, it has not been shown that *Slater* teaches, suggests, or otherwise discloses "creating a print out, the print out including [*inter alia*] the one or more first control codes, which are usable to authenticate the one or more respective approval marks, and the one or more second control codes, which are usable to validate the text content of the print out." The Office Action argues that various passages of both *Slater* and *Shioda* teach the elements of Claim 1. First, the Office Action cites to *Slater*, paragraphs 64 and 84. Nothing in these paragraphs teaches, suggests, or otherwise discloses a print out including the one or more first and second control

codes. Claim 1 teaches *both* one or more first control codes *and* one or more second control codes. The Office Action cites to *Slater*, paragraphs 31–34, and argues that *Slater* discloses both, but only refers to one section of *Slater*. In fact, the Office Action repeats the same argument, referencing a single passage from *Slater*, to show two separate instantiations of a control code. *See* Office Action at 8–9 (citing *Slater* ¶ 31–34). It has not been shown, however, that *Slater* discloses a first and second control code. The Office Action then cites to *Shioda*, col. 2, lines 28–63, as support for the argument that *Shioda* teaches printing a full-sized version of the document. Nothing in the cited portion of *Shioda* teaches, however, a print out including first and second control codes as described above. Accordingly, Applicant respectfully requests withdrawal of the rejection.

For at least the foregoing reasons, Applicants request that the rejections of the present claims be withdrawn and the claims be allowed.

CONCLUSION

Applicant has made an earnest attempt to place this case in condition for allowance. It is believed that all of the pending claims have been addressed. Applicant notes that the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all Claims.

If the present application is not allowed and/or if one or more of the rejections is maintained, Applicant hereby requests a telephone conference with the Examiner and further requests that the Examiner contact the undersigned attorney to schedule the telephone conference.

Applicant believes no fees to be due, however, the Commissioner is hereby authorized to charge any fees or credit any overpayments to deposit account 06-1050.

Respectfully submitted,

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